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09/248,595    02/11/99    FEENEY    B    P-5761-SPALD

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EXAMINER

ARYANPOUR, M

ART UNIT

PAPER NUMBER

3711

DATE MAILED:

07/03/00

*15*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/248,595

Applicant(s)  
Brian P. Feeney et al

Examiner  
Mitra Aryanpour

Group Art Unit  
3711



☒ Responsive to communication(s) filed on May 16, 2000

☒ This action is FINAL.

*incorrectly marked - 10/20/00*

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-20 is/are pending in the application

Of the above, claim(s) 19 and 20 is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☒ Claim(s) 1-18 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Election/Restriction*

1. Newly submitted claims 19-20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 19 and 20 are directed to a method of assembling a game ball from a leather sheet having water resistant properties prior to assembling the game ball from the leather.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### *Specification*

2. The amendment filed 05/16/2000 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: There is no support that a game ball has been subjected to a combination of “three 90 minute cycles of a rain test,” and “six 45 minute cycles of the rain test”.

Applicant is required to cancel the new matter in the reply to this Office action.

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*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 2, 3 and 4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, applicant is claiming a “game ball having moisture resistance properties, said game ball comprising a lining and a leather cover disposed over said lining”, however, the game balls tested by applicant also have bladders. In Example 1, the game ball has a bladder, a lining and a cover. In Comparative Example 1, the game ball has a bladder and a cover but no lining.

There is no support for claim 3 in the specifications, drawings or the tables. Claim 3 is dependent on claim 1, claim one recites the limitation on lines 4-5, “three 90 minute cycles of a rain test,” however, since claim 3 is dependent on claim 1, it would recite the same aforementioned limitation, including the limitations on lines 1-2 of claim 3, “ball is subjected to six 45 minute cycles of the rain test”. There is no support that a game ball has been subjected to not only the “three 90 minute cycles of a rain test,” but also the “six 45 minute cycles of the rain test”.

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Walters (5,069,935)** in view of **Carlson (3,708,333)**.

Walters shows a game ball with a tanned leather cover (26) that has moisture resistance; a lining (27) made from a sheet (28) of vinyl-impregnated polyester fabric containing two or three plies; and an inflatable bladder (34) made of butyl rubber or a synthetic material known in the art (Column 3, lines 38-52 and Column 4, line 24-27).

Walters shows three methods of applying the water repellent material to the back side of the leather 1) airless-type spray; 2) roller-coat and 3) submerge the entire panel.

Walters shows two ways of testing a game ball 1) Spray Test; 2) Submersion Test. Walters shows that using a water spray test method (to simulate rain) resulted in unreliable and erratic test results, in any event, Walters lacks test data for a football subjected to a "rain test".

Carlson shows a leather-like sheet material with a slow rate of water pickup by forming a water-laid sheet containing leather fibers, impregnating the water-laid sheet with an uncured polyurethane elastomeric resin system, and permitting the uncured resin system to cure in situ.

A particularly advantageous feature of cured sheets made according to Carlson's invention

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is the slow water pickup rate. The water pickup up rate is the percent of water absorbed at room temperature by an initially dry sample in a given increment of time. The percent of water absorbed can be expressed as either weight percent (based on the weight of the dry sample) or volume percent (based on the apparent volume of a dry sample). All measurements are in grams and cubic centimeters, and the density of water at room temperature is assumed to be exactly one gram per cc. If W1 is the weight of the dry sample and W2 is the weight of the sample after immersion in a room temperature water bath, the weight percent water absorption will be given by:  $100 \times (W2 - W1)/W1$  (Column 5, lines 11-55).

As can be seen from the aforementioned, applicants claimed testing method is not new, and it would have been obvious to one having ordinary skill in the art at the time the invention was made to further utilize Carlson's method of testing on a leather sample and apply the test method to a game ball. Game balls as disclosed by Walter's background description (Column 1, lines 6-44) are well known and are traditionally made of a tanned leather cover with inherent water resistant qualities, a 2- or 3-ply lining made of vinyl-impregnated polyester fabric or other suitable water resistant material, and with or without a bladder made of butyl rubber or any other suitable material well known in the art.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the Carlson test method to Walters football in order to simulate similar conditions as on the playing field and to further determine how the balls hold up in wet conditions and how much water is absorbed by the balls at the end of each designated cycle.

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Any other possible distinctions over the thus modified device would be obvious in view of other prior art referenced in order to obtain the known advantages thereof.

In reference to claims 5-7, it would have further been obvious to one having ordinary skill in the art at the time the invention was made to use various lining material, as it is shown by Walters (Column 3, lines 43-45), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious material choice. *In re Leshin*, 125 USPQ 416.

In reference to claim 15, as can be seen from Walters reference making various types of game balls such as an American-style football using a leather or a leather-like material would be deemed obvious.

#### ***Response to Arguments***

7. Applicant's arguments filed 11/17/1999 have been fully considered but they are not persuasive.

The rejection of claims 1-3 and 8-9 using applicant's disclosure has been withdrawn. The appropriate rejection should have been incorporated into 35 USC 112.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., game ball is placed in a test chamber and an oscillating water spray is disposed over the game ball) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations

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from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant is not claiming the method of testing a game ball by placing a game ball in a test chamber and subjecting the game ball to an oscillating water spray. Carlson shows a game ball being subjected to water by submergence, and Walters shows two possible methods of testing and three methods of applying the water repellent material, however, Walters points out that the sprinkler method was unreliable. Walters further points out that the submergence test was not designed to duplicate the conditions during an inclement situation but rather was designed as an extremely severe test whereby a football exposed to water could be reliably judged. As pointed out above the claims are not directed to a method of testing a game ball.

With respect to subjecting a game ball to various cycles of tests for various periods of time would be considered obvious, since it would be at the tester's discretion to subject the game ball to however many cycles and for as long as necessary to achieve the results needed for the intended purpose.

With respect to the relevancy of the Walters and Carlson references, Walters clearly shows a game ball having a bladder a lining and a cover that has been subjected to various tests to see how well it holds up in real conditions. Carlson shows a cure leather-like material containing leather fibers with superior water resistant qualities, also subjected to various tests to show the rate of water pickup. To use Carlson's leather-like material to make a game ball as it is shown by Walters and



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then subjecting the game ball to tests similar to the tests taught by either Carlson or Walters would be considered obvious.

Applicant does not indicate in the claims that the game ball can not be pre and post-assembly coated, in any event in "pre-assembly" the tanned leather of Walters is coated which can be considered a part of the tanning process.

If the claimed game ball has superior qualities with respect to the existing game balls, the applicants should indicate as much. If the game ball is superior because of the type of leather used in combination with the bladder and the lining, then applicant should perhaps elaborate on the specifics of the leather, the bladder and the lining and how it is put together to achieve superior results.

### *Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is (703) 508-3550. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette Chapman, can be reached on (703) 308-1310. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7768.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

MA

June 28, 2000

  
JEANETTE CHAPMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700